

No. 15,128
IN THE
United States Court of Appeals
FOR THE NINTH CIRCUIT

ROBERT W. BROWN & Co., INC., ROBERT W. BROWN and
OLIVE W. BROWN,

Appellants,

vs.

LEONARD DeBELL (substituted for U. S. License Frame
Mfg. Co.),

Appellee.

BRIEF FOR APPELLEE.

FULWIDER, MATTINGLY & HUNTLEY,
ROBERT W. FULWIDER and
WILLIAM K. YOUNG,

5225 Wilshire Boulevard,
Los Angeles 36, California,

Attorneys for Appellee.

FILED

NOV 27 1956

PAUL P. O'BRIEN, CLERK

TOPICAL INDEX

	PAGE
I.	
Statement of the case.....	1
II.	
Summary of argument.....	3
III.	
Argument.....	5
A. The Bessolo patent is valid as exemplified by the absence of anticipatory art.....	5
B. The commercial success and copying of the design in question by competitors emphasizes the validity of the Bessolo patent	11
C. The law of the subject fully sustains the validity of the Bessolo patent	14
D. The Bessolo patent is clearly infringed by the defendants' license frames	23
E. The law of infringement sustains the judgment of the lower court	26
IV.	
Conclusion	27

TABLE OF AUTHORITIES CITED

CASES	PAGE
Anthonson v. Hedrick, 89 F. 2d 149, 33 U. S. P. Q. 180.....	16
Bourquin, dba Savoy, etc. v. Grandinetti, 43 Fed. Supp. 523, 52 U. S. P. Q. 160.....	21
Columbia Protektosite Co. v. Great American Plastics Co., 112 Fed. Supp. 39, 97 U. S. P. Q. 57.....	20
Dietz, etc. v. Burr, etc., 243 Fed. 592.....	7
Dobson v. Dornan, 118 U. S. 110.....	9, 27
Donaco Plastics v. Tray-Ware, 87 U. S. P. Q. 29.....	20
Falcon Industries, Inc., et al. v. R. S. Herbert Co., Inc., et al., 128 Fed. Supp. 204, 104 U. S. P. Q. 301.....	7, 20
Forestek Plating v. Knapp-Monarch Co., 106 F. 2d 554, 43 U. S. P. Q. 39.....	21, 27
Fouch, dba Universal Microphone v. Associated Projects Co., 79 U. S. P. Q. 259.....	21
Gasifer Mfg. Co. v. General Motors Corp., 138 F. 2d 197, 59 U. S. P. Q. 259.....	16
Glen Raven, etc. v. Sanson, etc., 189 F. 2d 845, 89 U. S. P. Q. 470.....	9, 11, 17, 18, 19, 21, 22, 26
Gomez, et al. v. Granat Bros., et al., 177 F. 2d 266.....	5, 6
Gorham v. White, 80 U. S. 511.....	9, 17, 18, 26
Krieger v. Colby, 106 Fed. Supp. 124, 95 U. S. P. Q. 4.....	20
Laskowitz v. Marie-Designer, Inc., 119 Fed. Supp. 541, 100 U. S. P. Q. 367.....	20
Nebel Knitting Co. v. Sanson Hosiery Mills, Inc., 214 F. 2d 781, 102 U. S. P. Q. 142.....	21
Palmer Company v. Luden's, Inc. 128 Fed. Supp. 672, 104 U. S. P. Q. 246.....	20
R. M. Palmer Company v. Luden's, Inc., 111 U. S. P. Q. 1....	12, 20
Ruth v. Climax Molybdenum Co., 93 F. 2d 699, 36 U. S. P. Q. 128	16

	PAGE
Sanson Hosiery Mills v. Warren Knitting Mills, 202 F. 2d 395, 96 U. S. P. Q. 247.....	20, 21
Sanson Hosiery Mills, Inc., et al. v. H. S. Kress Co., Inc. 109 Fed. Supp. 383, 95 U. S. P. Q. 142.....	22, 26
Sanson Hosiery Mills, et al. v. Warren Knitting Mills, Inc., 95 U. S. P. Q. 138.....	22
Sel-O-Rak Corp. v. Henry Hanger & Display Fixture Corp. of America, et al., 232 F. 2d 176, 109 U. S. P. Q. 179.....	9
Standard Match Corp. v. Bell Mach. Co., 83 F. 2d 365, 29 U. S. P. Q. 217.....	12
Wallace & Sons v. The Ellmore Silver Co., 91 Fed. Supp. 703, 85 U. S. P. Q. 479.....	20
Whiteman v. Matthews, 216 F. 2d 712.....	9, 10

RULES

Federal Rules of Civil Procedure, Rule 52(a).....	16
---	----

No. 15,128

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

ROBERT W. BROWN & CO., INC., ROBERT W. BROWN and
OLIVE W. BROWN,

Appellants,

vs.

LEONARD DEBELL (substituted for U. S. License Frame
Mfg. Co.),

Appellee.

BRIEF FOR APPELLEE.

I.

STATEMENT OF THE CASE.

This case is for infringement of Design Letters Patent No. D-167,878 granted October 7, 1952 to Joseph C. Bessolo. The patent covers a design for an automobile license plate holder. Bessolo assigned the rights to said patent to the original plaintiff, U. S. License Frame Manufacturing Co. Before trial, Leonard DeBell, the present plaintiff was substituted for plaintiff.

The complaint alleges that defendant Robert W. Brown & Co., a California corporation, and defendants Robert W. Brown and Olive W. Brown, husband and wife and president and secretary, respectively, of said corporation infringed the Bessolo design patent.

The defendant corporation was incorporated in July of 1953. Prior to that time the original plaintiff, U. S. License Frame Mfg. Co. had long been engaged in the manufacture and sale of automobile license plates.

The defendant Robert W. Brown had been for some period of time selling license plate frames manufactured by U. S. License Frame Mfg. Co. Brown obtained orders as a sales representative and said orders were billed directly to the customer by the U. S. License Frame Mfg. Co. and all remittances were sent directly to the U. S. License Frame Mfg. Co. including any collections made by the defendant Robert W. Brown [R. 158].

During the time the defendant Robert W. Brown was selling license frames of the design of the Bessolo patent and manufactured by U. S. License Frame Mfg. Co. he took an order for delivery to Eddie Nelson Inc. [R. 158]. The U. S. License Mfg. Co. delivered a portion of said order and thereafter the defendant Robert W. Brown and U. S. License Frame Mfg. Co. severed their relationships [R. 164, 165]. Subsequent to severing of relationships between U. S. License Frame Mfg. Co. and defendant Robert W. Brown, the defendant Robert W. Brown arranged the cancellation of an unfilled balance of said order which he had taken for U. S. License Frame Mfg. Co. and under which part shipment had been made [R. 159].

The defendant Robert W. Brown proceeded to supply infringing frames as indicated by Exhibit 2 to Eddie Nelson Inc. [R. 160]. The defendant not only supplied license frames to Eddie Nelson Inc. but also to a number of other users. One of the other such frames so supplied

by defendant is the "Phil Hall" frame, one sample of which is plaintiffs' Exhibit 4 [R. 31].

From judgment for plaintiff the defendants have appealed.

The appellants have stated that the questions for determination are as follows: (1) Does the Bessolo design patent in suit embody any invention over the prior art?, and (2) Does the accused device contain that invention?

More correctly stated, the questions are: (1) Is the Bessolo design patent valid?, and (2) Have the defendants infringed the Bessolo patent?

II.

SUMMARY OF ARGUMENT.

A. THE BESSOLO PATENT IS VALID AS EXEMPLIFIED BY ABSENCE OF ANTICIPATORY ART.

The Patent Office has diligently searched and failed to find any anticipatory art. The additional art cited by appellants is even less pertinent than that considered by the Patent Office and rejected by the Patent Office as not being anticipatory.

The Trial Court found that the file wrapper reference patents did not negate the invention of the patent and found that the additional references of the defendants were even less relevant and did not disturb the validity of the patent. The Gazan patent considered by the Court was found to show only that the Patent Office fully considered all issues raised in connection with the Gazan and Bessolo patents and decided in favor of the validity of the Bessolo patent.

B. THE COMMERCIAL SUCCESS AND COPYING OF THE BESSOLO DESIGN BY COMPETITORS EMPHASIZES THE VALIDITY OF THE BESSOLO PATENT.

The Court found that the design of the patent in suit met with widespread acceptance in the trade and with great commercial success and widespread copying by competitors thus strengthening the presumption of validity already attached to the issuance of the patent.

C. THE LAW ON THE SUBJECT FULLY SUSTAINS THE VALIDITY OF THE BESSOLO PATENT.

The presumption of validity of the patent was found to be sustained by the facts and the evidence, both oral and documentary, which fully supported the finding of the Court that the Bessolo patent is valid.

D. THE BESSOLO PATENT IS INFRINGED BY THE DEFENDANTS' LICENSE FRAMES.

All essential characteristics of the Bessolo patent are found to be present in the defendants' license frames. The Court found that they were substantially identical with the design of the patent and that they embody the invention of the Bessolo patent and are an infringement thereof.

E. THE LAW OF INFRINGEMENT SUSTAINS THE JUDGMENT OF THE LOWER COURT.

The law as repeatedly expressed regarding design patents is clear that the copying of a design embodying a new and pleasing combination which has been patented constitutes infringement.

III.

ARGUMENT.

A. The Bessolo Patent Is Valid as Exemplified by the
Absence of Anticipatory Art.

The references cited and actions taken by the Examiner in the Patent Office prove conclusively that he was diligent in searching for prior art and that he located all references which might conceivably be of any importance.

That there is a presumption of validity of a patent is not disputed by the appellants, but on the contrary, is admitted. The appellants attack the presumption of validity on the ground that certain prior art was perhaps not considered by the Patent Office. On the other hand, it is quite clear from the file wrapper, and from an examination of the alleged references that the defendants think perhaps were not considered, that on the contrary all conceivable references *were* considered, and the Examiner was most diligent in his search. In this regard the appellant makes much of the ruling by this Court in the case of *Gomez, et al. v. Granat Bros., et al.*, 177 F. 2d 266 (1949), in which the Court said in part:

“The presumption of *prima facie* validity of patent is greatly weakened, if not destroyed, when *pertinent* prior art is not considered by the Patent Office.”
(Emphasis added.)

It is most important that the word “pertinent” and its importance be considered with reference to this case and other citations and argument of the appellants in this regard. It is further important to note that if the case of *Gomez, et al. v. Grant Bros. et al.*, be reviewed more thor-

oughly, it will be clear that a different situation existed than in the case at suit. In the *Gomez* case it will be noted that of a large number of prior art patents apparently none were referenced or considered by the Patent Office.

In the case at bar it is quite clear that the Trial Court did not consider the designs of McRuer [Ex. N], Orester [Ex. M], Western Auto [Ex. J-1] or Douglas [Ex. A-1] as worthy of citing against the Bessolo design. In particular the court found:

“documentary exhibits submitted by the Defendants as prior art, the catalog Exhibit J and the Orester and McRuer patents, Exhibits M and N, are not as relevant as the patents relied on by the Examiner and in no way disturb the validity of the patent in suit.” [R. 20.]

With regard to the Douglas Company frames the Court found:

“The license frames illustrated in Exhibit A-1 and before the Court as Exhibits A-5, A-10, and A-15, are simple stampings with silk screen lettering thereon, the overall appearance of which is materially different from that of the license frames sold by plaintiff under the patent in suit.” [R. 21.]

Further the Court found that the Douglas Frames were in all material respects the same as the frames illustrated by file wrapper reference patents. The Court repeatedly found that each and every so-called anticipation was, in fact, not anticipation and not relevant.

The McRuer [Ex. N] and Orester [Ex. M] patents require no discussion since they bear none of the features of the patent at bar unless it be that above and beneath the space where numbers will appear there are places in

which advertising matter may appear. In both cases, it will be observed that neither of the patents discloses a design which would appear to suggest the Bessolo design to a casual observer or to an expert.

With further reference to the Douglas Frames, not only did the Court find as above indicated that they did not anticipate the plaintiff's patent but in addition the Court found that they were of very little evidentiary value [R. 21].

Appellants state that the design is utilitarian and functional, but this is immaterial. The Court is fully aware of the law that the mere fact that the object has utilitarian and functional features does not defeat nor in any manner interfere with the validity of a design patent.

The recent case of *Falcon Industries, Inc., et al. v. R. S. Herbert Co., Inc., et al.*, 128 Fed. Supp. 204, 104 U. S. P. Q. 301, in which a design patent for a smoker's pipe was found valid and infringed, fully expresses the law in this regard; in this case, the Court stated at page 212:

"Invalidity is further urged because of the functional elements of plaintiff's design, and if this means that only a design which comprehends no useful elements can be the subject of a valid design patent, it does not correctly state the law. The statute is not restricted to solely esthetic concepts."

"Judge Hough said in *Diets, etc. vs. Burr, etc.*, 243 F. 592 at 594:

"While design patents are not intended to protect a mechanical function, or to secure the patentee monopoly in any given mechanism or manufacture as such, it is immaterial that the subject of the design may embody a mechanical function, provided that the design *per se* is pleasing, attractive, novel, useful and

the result of invention. *Ashley v. Weeks, etc. Co.*, 220 F. at 901, 136 C. C. A. 465. But it is the design that is patented, not the mechanism dressed in the design.' ”

The important features of the Bessolo design are clear and apparent from the design itself and from the argument advanced by Bessolo's counsel in the Patent Office prosecution, to which appellants have made a partial reference on page 7 of their brief. Appellants indicate the weakness of their case by attempting to divert the attention of the Court from the essential facts by indicating an incomplete, and therefore misinformative portion of the facts. The full and complete reference to the Bessolo file wrapper shows that it was stated:

“Furthermore, no one frame has depressed, dimpled indicia surfaces with smooth-faced letters on both upper and lower faces of the one frame.”

and further stated:

“As to the differences in specific features, it will be noted that the indicia surfaces are dimpled, that the lower indicia surface is almost double the width of the upper indicia surface, so that the lower surface indicia may be emphasized over the upper indicia. These are features which have made these frames very attractive, as evidenced by the success thereof since they were designed.” [Ex. G-8.]

The effect of any alleged anticipation upon the presumption of validity must relate to the word “pertinent” as used in the cases cited by the appellant. It is quite obvious that there has been no *pertinent* prior art; thus, it is equally clear that the presumption of validity must stand and that such validity is strongly born out by this very point.

It is clear and well established law that every design must, of necessity, embody something old and known. It is how the old and known elements are used which determines invention. This point is well expressed in *Sel-O-Rak Corp. v. Henry Hanger & Display Fixture Corp. of America, et al.*, 232 F. 2d 176, 109 U. S. P. Q. 179, a Fifth Circuit case decided April 18, 1956, in which validity of a design patent was upheld and in which the Court said among other things as follows at page 178:

“In our consideration of the basic question as to the validity of the patent, we start with the knowledge that every design must of necessity embody something old and known. Design being only a rearrangement of line and form, it must always depend upon elements that are in a strict sense old. We are not impressed, therefore, with appellee’s attack on the design patent here on the ground that it combined known components. The straight line, the square, the circle, the cube, triangle and sphere are all known components. They are all old. But any design patent, it seems to us, must, of necessity, combine some of these elements.”

The design patent law which is accepted by all authorities is found in *Gorham v. White*, 80 U. S. 511 and *Dobson v. Dornan*, 118 U. S. 110 and the cases subsequent thereto emphasizing and affirming the points therein made. To avoid repetition and to shorten this brief the *Gorham* and *Dobson* cases are referred to in connection with *Glen Raven, etc. v. Sanson, etc.*, 189 F. 2d 845, 89 U. S. P. Q. 470, which is quoted at length under Point C of this Argument. *The law on the subject fully sustains the validity of the Bessolo patent.*

The case of *Whiteman v. Matthews*, 216 F. 2d 712, 1954, is cited by the appellants as proof that testimony of certain

witnesses is not to be disregarded and that the testimony in this case establishes invalidity of the patent.

Of course, the citation, as quoted in appellants' brief certainly does express the law. However, it is necessary to read a little more of the case of *Whiteman v. Matthews* to get the full import of what this Court said in that case. In that case there was an appeal from a judgment of invalidity of a patent. On appeal it was held that the Trial Court's decision was correct based upon the facts and the findings of the Trial Court and it is a portion of this decision which the appellants have quoted.

This Court, in that case, *held that the Trial Court alone had the opportunity to see and hear the witnesses testifying* and said in part as follows:

“Finally, the Trial Court alone had the opportunity to see and hear the witnesses testifying regarding the Spencer machine and to use that invaluable aid in judging the credibility of such witnesses and the weight which should be given to their testimony. Taking into account all of the foregoing, we cannot say that the Court below was in error in its finding of prior public use of the Spencer machine.”

It is clear that this Court in the *Whiteman v. Matthews* case fully expressed the well established rule that the Trial Court is in a position to adequately and properly judge and rule upon questions of fact and to evaluate the testimony. This is exactly the position of appellee in the case at bar, to wit, that the Trial Court has made its findings regarding these facts, has made them upon good and sufficient evidence, and its decision should be affirmed.

And further, in the case at bar the Trial Court found the testimony of the defendants' witnesses “neither convincing nor persuasive.” [R. 24.]

B. The Commercial Success and Copying of the Design in Question by Competitors Emphasizes the Validity of the Bessolo Patent.

The license frames of the Bessolo design met with immediate and outstanding commercial success as emphasized by the testimony of the witness Wallace Titzel [R. 149]. The question of commercial success indeed, is not questioned by the appellants and the record indicates that the appellants were successful in the sale of their infringing product. The defendant Robert W. Brown testified:

“We had been working day and night completing orders and delivering orders that we had” [R. 165].

The law is clear that commercial success is of great importance in determining the validity of a design patent and has a great bearing upon the case. The case of *Glen Raven Knitting Mills, Inc. v. Sanson Hosiery Mills, Inc. et al.*, 189 F. 2d 845, 89 U. S. P. Q. 470, a Fourth Circuit case is of great interest in many respects in comparison to the case at bar, and it makes particular reference to commercial success. In the Glen Raven case the patent in question was a design patent for a so-called “picture frame” reinforced heel for ladies stockings. The principal characteristic of this patent was a border about the reinforced area of the heel. In connection with the commercial success in said case the Court stated among other things at page 853 as follows:

“The especial importance of commercial success in determining the validity of design patents is recognized by the decisions of the Courts. See *J. R. Wood & Sons, Inc. vs. Abelsons, Inc.*, 3 Cir., 74 F. 2d 895 [24 USPQ 4]; *Standard Match Corp. v. Bell Mach. Co.*, 7 Cir., 83 F. 2d 365, 367 [29 USPQ 217, 218-219]. The immediate success of the ‘Picturesque’,

‘Picture Frame’ and ‘Dupliquette’ stocking, its command of a higher price, its refined simplicity and ease of manufacture, its acceptance by competitors, and its reception and acclaim by the world-wide public all attest to something more than commonplace ornamentation or uninspired reassembly of old ideas.”

The foregoing case was cited with approval in the case of *R. M. Palmer Company v. Luden’s, Inc.*, 111 U. S. P. Q. 1, a Third Circuit case decided August 22, 1956 in which design patents were held valid and infringed. Another case particularly pointing out the importance of this factor in sustaining the validity of a design patent is *Standard Match Corp. v. Bell Mach. Co.*, 83 F. 2d 365, 29 U. S. P. Q. 217, a Seventh Circuit Court. In this case the patent was held valid and infringed and the Court said, among other things at page 367:

“In view of what was said in *Wahl Clipper Corporation vs. Andis Clipper Co.*, 66 F. (2d) 162, we would have been better satisfied if the parties had furnished us with more complete and detailed evidence of the public’s reception of these bibelots. Whether a design which is novel and ornamental is entitled to coverage by design patent depends to a large degree upon the reception which those for whom it is made, accord it. If pleasing to the eye and acceptable to the trade as evidenced by extensive sale, we would naturally be inclined to uphold it.”

In the *Standard Match* case the Court went on to say that apparently the evidence indicated commercial success. This appeared to be a very important particular in this case.

In the case at bar there is ample evidence that prior designs and the Bessolo design, were sold competitively but that the Bessolo design was much preferred [R. 149, 153, 154 and 123]. See Finding 16 in which the Trial Court found:

“Following the first sale by the plaintiff U. S. License Frame Mfg. Co. of license frames embodying the design invention of the patent in suit, said plaintiff continued to manufacture and sell said license frames, and in spite of the fact that their selling price was higher than other designs sold by Plaintiff, said sales continued to increase over the years with respect to and until they surpassed other designs of license frames manufactured and sold by Plaintiff. Said license frames embodying the design of the patent in suit were substantially copied by numerous competitors in the field. This commercial acceptance by the trade of license frames embodying the design of the patent in suit and particularly the widespread copying thereof by competitors strengthens the presumption of validity attaching to the issuance of the patent.” [R. 16 and 17, Finding 16.]

In the case at bar, the appellants apparently agree that the design in suit is a great advance over any prior design since they deliberately sought out, selected and copied the design of the patent in suit over all of the alleged prior art which was equally available to them. For example, the Watts, Overton, and Orestor patents had expired long before defendants commenced their operation and could have been used with complete impunity, but defendants chose to appropriate the Bessolo design.

C. The Law of the Subject Fully Sustains the Validity of the Bessolo Patent.

The findings of the Trial Court completely support the validity of the Bessolo patent. The Court found that the design had been well and favorably received in the trade and that although the plaintiff continued to manufacture and sell frames of a lower price than the sales of frames embodying the design of the Bessolo patent continued to increase and surpass the other designs manufactured and sold by the plaintiff and that there was widespread copying thereof by competitors. [R. 16 and 17, Finding 6.]

The Court considered all the alleged prior art and found that none of the evidence anticipated or negated the invention of the patent in suit and in particular found as follows:

“Said file wrapper reference patents do not anticipate or negative invention of the patent in suit and the Examiner did not err in allowing and issuing said patent.” [R. 20.]

and

“As to the other documentary exhibits submitted by defendants as prior art, the catalog Exhibit J, and the Orestor and McRuer patents Exhibits M and N, are not as relevant as the patents relied upon by the Examiner and in no way disturb the validity of the patent in suit. The Gazan patent, Exhibit H, is later in point of time and therefore not prior art against the patent in suit. The Gazan file wrapper, Exhibit I, is relevant only to show that the Patent Office fully considered all issues raised in connection with the Gazan and Bessolo patents and decided same in favor of the Bessolo patent in suit.” [R. 20, Finding 14.]

The Court also considered the deposition of Stanley M. Olson and the Douglas Company exhibits and found they were of little evidential value and in particular found that even taking them at their face value and conceding facts not proven, still

“they do not anticipate the ornamental design of the patent in suit, which demonstrates invention over said exhibits.” [R. 21, Finding 16.]

The Court further considered the so-called Cobb frame and found among other things

“there is no evidence whatsoever that frames made according to Exhibit 5 were made or sold prior to March 6, 1948, the effective date of the patent in suit.” [R. 22.]

With further regard to the Douglas frames and mentioning the Overton and Griffith file wrapper patent references, Exhibits G-3 and G-2, the Court found in Finding 18:

“None of said exhibits shows the ornamental design of the Bessolo patent and none of said exhibits, taken singly or in combination, supports defendants’ contentions of lack of novelty and invention.”

With reference to the testimony concerning manufacture and sale of license frames, Exhibits C, D and K, the Court stated in Finding 19 as follows:

“The testimony concerning the manufacture and sale of license frames, Exhibits C, D and K, prior to the invention of the patent in suit, is not convincing. At best, it merely shows the existence of two-cavity master dies which *might have* been used to produce said frames but which were equally suitable for and were commonly used to make other and different kinds of frames of varying sizes to meet the

requirements of various state laws. Master dies are made for the express purpose of permitting the manufacture by the use of but one die of many different kinds of frames. The evidence as to the use of such dies before the patent in suit to make frames of any particular design and specifically frames similar to Exhibits C, D, and K is neither convincing nor persuasive. The evidence as to said exhibits does not disturb the validity of the patent in suit which clearly discloses and claims a new and ornamental design." [R. 23 and 24, Finding 19.]

There is a large amount of evidence, both oral and documentary to fully support all findings of the trial court in this case and the Ninth Circuit Court of Appeals and other Circuit Courts have repeatedly recognized and reiterated that in patent cases, as in other cases, the findings of fact of the trial court, where supported by substantial evidence, should not be set aside.

Anthonson v. Hedrick (C. C. A. 9), 89 F. 2d 149, 151, 33 U. S. P. Q. 180, 182;

Gasifer Mfg. Co. v. General Motors Corp. (C. C. A. 8), 138 F. 2d 197, 199, 59 U. S. P. Q. 259, 261-262;

Ruth v. Climax Molybdenum Co. (C. C. A. 10), 93 F. 2d 699, 702, 36 U. S. P. Q. 128, 131-132.

Rule 52a of the Rules of Civil Procedure succinctly states it as follows:

"Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge the credibility of the witnesses."

The case accepted by all authorities as *the* leading case on design patent law is the decision of the Supreme Court

in *Gorham v. White*, 81 U. S. 511. The *Gorham* case was cited with approval in the Fourth Circuit Court case of *Glen Raven, etc. v. Sanson, etc.*, 189 F. 2d 845, 89 U. S. P. Q. 470, in which the Court quoted from the *Gorham* case as follows:

“The acts of Congress which authorize the grant of patents for designs *were plainly intended to give encouragement to the decorative arts. They contemplate not so much utility as appearance*, and that, not an abstract impression, or picture, but an aspect given to those objects mentioned in the acts. * * * And the thing invented or produced for which a patent is given is *that which gives a peculiar or distinctive appearance to the manufacture, or article to which it may be applied, or to which it gives form. The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its saleable value, may enlarge the demand for it, and may be a meritorious service to the public.* It therefore proposes to secure for a limited time to the ingenious producer of those appearances the advantages flowing from them. Manifestly the mode in which those appearances are produced has very little, if anything, to do with giving increased saleableness to the article. *It is the appearance itself which attracts attention and calls out favor or dislike. It is the appearance itself, therefore, no matter by what agency caused, that constitutes mainly if not entirely the contribution to the public which the law deems worthy of recompense. The appearance may be the result of peculiarity of configuration, or of ornament alone, or of both conjointly, but, in whatever way produced, it is the new thing, or product which the patent law regards.* * * * We do not say that in determining whether two designs are substantially the same,

differences in the lines, the configuration, or the modes by which the aspects they exhibit are not to be considered; but we think the controlling consideration is the resultant effect.” (Emphasis added.)

The basic concept of design patent protection as enunciated in *Gorham v. White* has been the accepted standard in all circuits, and is still the basis of this part of the patent law.

In the *Glen Raven* case, the Court was adjudicating Design Patent No. 151,732 for a lady’s stocking with an ornamental heel portion. The decision includes pictures of the plaintiff’s and defendant’s design, and of the most pertinent prior art patents, and thoroughly reviews the law in a masterly fashion. In speaking of the question of validity, the Court of Appeals in the *Glen Raven* case states as follows:

“Validity is to be tested by the appearance of the patented design as a whole. *Dobson v. Dorman*, 118 U. S. 10, 15. ‘A combination of elements that are old is patentable, if it produces a new and useful result as the product of the combination; and a design which avails itself of suggestions old in art is patentable if, as a whole, it produces a new and pleasing impression on the aesthetic sense.’ *Matthews & Willard Mfg. Co. v. American Lamp & Brass Co.*, 3 Cir., 103 F. 634, 639.” (Emphasis added.)

Further quoting from the *Glen Raven* case, we find the Court of Appeals stating as follows:

“It is true that the patent lies in a restricted field and pertains to an article that may seem of minor importance in the development of the industrial arts. But all design patents are of the limited scope which is attendant upon appearance rather than utility; and Congress has ordained in the statute covering

design patents, 35 U. S. C., Sec. 73, that a patent shall be granted 'to any person who has invented any new, original and ornamental design for an article of manufacture.' *It is on this plane that the merits of the design must be judged*; and it must be borne in mind that the inventive skill as well as the originality, which are essential to validity, relate entirely to the appearance of the article and the appeal to the eye." (Emphasis added.)

With respect to the added weight given to commercial success in evaluating *design* inventions, the Court in the *Glen Raven* case says:

"It is therefore obvious that in dealing with patents of this kind much weight must be given to commercial success, and all the more so when wearing apparel, which must please the buyer, is the subject to which the design applies. No one will deny the great practical importance of the manufacture of women's clothing in the industrial field or that persons skilled in the art are constantly endeavoring to produce garments that will have popular appeal. The fact that prior to the spectacular success of the Bley design such an effort was made for a long period in the limited field to which this case applies is sufficient proof that the patentee's contribution was not obvious to the ordinary person, and justifies the finding that the patent is valid. *The especial importance of commercial success in determining the validity of design patents is recognized by the decisions of the Courts.* See *J. R. Wood & Sons, Inc. v. Abelson's Inc.*, 3 Cir., 74 F. 2d 385 (24 U. S. P. Q. 4); *Standard Match Corp. v. Bell Mach. Co.*, 7 Cir., 83 F. 2d 365, 367 (29 U. S. P. Q. 217, 218-219). The immediate success of the 'Picturesque,' 'Picture Frame' and 'Dupliquette' stockings, its command of a higher price, its refined simplicity and

ease of manufacture, its acceptance by competitors, and its reception and acclaim by the world-wide public all attest *to something more than commonplace ornamentation or uninspired reassembly of old ideas.*" (Emphasis added.)

The Bley design patent was also held valid and infringed in the Third Circuit in the case of *Sanson Hosiery Mills v. Warren Knitting Mills*, 202 F. 2d 395, 96 U. S. P. Q. 247.

Other recent cases holding design patents valid and infringed are:

Laskowitz v. Marie-Designer, Inc. (D. C. So. Cal.), 119 Fed. Supp. 541, 100 U. S. P. Q. 367 (contour chair—valid and infringed);

Palmer Company v. Luden's, Inc. (D. C. Pa.), 128 Fed. Supp. 672, 104 U. S. P. Q. 246 (affd. by C. A. 3);

R. M. Palmer Company v. Luden's, Inc., 111 U. S. P. Q. 1 (chocolate animals—valid and infringed);

Falcon Industries v. R. S. Herbert Co. (D. C. N. Y.), 128 Fed. Supp. 204, 104 U. S. P. Q. 301 (smoking pipe—valid and infringed);

Columbia Protektosite Co. v. Great American Plastics Co. (D. C. Mass.), 112 Fed. Supp. 39, 97 U. S. P. Q. 57 (toilet seat—valid and infringed);

Krieger v. Colby (D. C. So. Cal.), 106 Fed. Supp. 124, 95 U. S. P. Q. 4 (cap—valid and infringed);

Donaco Plastics v. Tray-Ware (D. C. Ohio), 87 U. S. P. Q. 29 (a supporting bracket—valid and infringed);

Wallace & Sons v. The Ellmore Silver Co. (D. C. Conn., 1950), 91 Fed. Supp. 703, 85 U. S. P. Q. 479 (a spoon—valid and infringed);

Fouch, dba Universal Microphone v. Associated Projects Co. (D. C. Ohio, 1948), 79 U. S. P. Q. 259 (a switch plate—valid and infringed).

See also:

Bourquin, dba Savoy, etc. v. Grandinetti (D. C. N. Y.), 43 Fed. Supp. 523, 52 U. S. P. Q. 160 (a fruit expressor—valid and infringed),

and,

Forestek Plating v. Knapp-Monarch Co. (C. C. A. 6), 106 F. 2d 554, 43 U. S. P. Q. 39 (a toaster and tray combination—valid and infringed),

in which the Court says:

“The object of the design statute is to encourage the decorative arts, and a new design, if it does no more than please the eye, is the proper subject of a design patent, regardless of utility, even though it is a reassembling or regrouping of familiar forms and decorations. *Protex Signal Co. v. Feniger*, 11 F. 2d 43 (C. C. A. 6); *Pelouse Scale & Manufacturing Co. v. American Cutlery Company*, 102 F. 916 (C. C. A. 7); *Franklin Knitting Mills, Inc. v. Gropper Knitting Mills, Inc.*, 15 F. 2d 375 (C. C. A. 2); *Graff Washbourne & Dunn v. Webster*, 195 F. 522 (C. C. A. 2).”

The preceding discussion has dwelt at length on the *Glen Raven* case and the cases therein cited. The patent involved in the *Glen Raven* case and declared valid and infringed therein was the subject of a large number of cases including:

Nebel Knitting Co. v. Sanson Hosiery Mills, Inc., 214 F. 2d 781, 102 U. S. P. Q. 142;

Sanson Hosiery Mills, Inc., et al. v. Warren Knitting Mills, Inc., 202 F. 2d 395, 96 U. S. P. Q. 247;

Sanson Hosiery Mills, et al. v. Warren Knitting Mills, Inc., 95 U. S. P. Q. 138;

Sanson Hosiery Mills, Inc., et al. v. H. S. Kress Co., Inc., 109 Fed. Supp. 383, 95 U. S. P. Q. 142,

in all of which the patents were held valid and infringed.

It is well to note the similarity of the patent in suit in the *Glen Raven* case and the other cases indicated as compared to the case at bar. The *Glen Raven* cases involve a so-called "picture frame" design around a reinforced heel of ladies' stockings. Thus, it can be seen that there is involved in the *Glen Raven* case a simple question of a frame of a specific design about a portion of an article.

It is clear that the same question is involved here and that we have a frame of specific design to go about a vehicle license plate.

In both the *Glen Raven* cases, which have had such repeated court support, and the case at bar there are certain characteristic features of the frame which make it appear to the eye to be something different from that which had preceded it in the art. That something which is different has made both achieve commercial success and has given both the pleasing quality desired by the public. And, in both, there were a number of efforts made in the limited fields for a long time before, but in each case no one before evolved the design which finally became the one which was successful.

D. The Bessolo Patent Is Clearly Infringed by the Defendants' License Frames.

The designs of both Bessolo and Brown are that of a generally rectangular license frame with rounded corners and a broad space at the top and bottom, one being wider than the other, and both of them being indented for the placing of the names of dealer and city within said indented spaces. The indented spaces are dimpled and smooth letters indicating the name of the dealer and city and placed within the dimpled areas. One of the spaces extends outward from the line of the edge of the frame and the other of said spaces is flush with the edge of the frame.

The appellants make much in their brief of the fact that the lower portion of the Bessolo design patent is broader than the upper portion, while this is reversed in the infringing Eddie Nelson article. Such a statement does not state the facts correctly, is incomplete, and is misleading.

The weakness of the appellants' position is very well exemplified by the attempt of the appellants to divert the Court's attention from the facts by a misleading view of the situation as indicated by the sketches attached to the appellants' brief and referred to on page 6 of appellants' brief.

It will be observed that the appellants have accurately portrayed the design of the Bessolo patent but they have not accurately portrayed the infringing frame, Exhibit 2, in the very important particular that the appellants

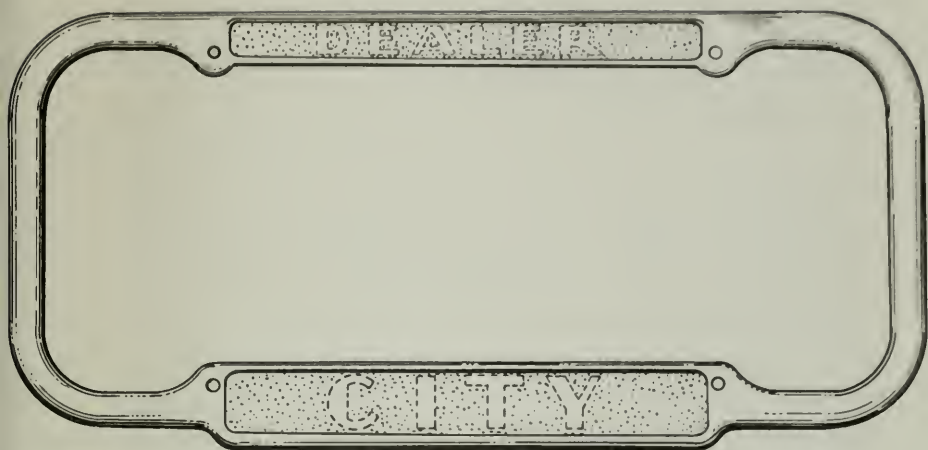
have omitted the dimpling of the recessed portion of the frame wherein the wording is attached.

This, however, is not so important as the fact that the appellants have made references on page 7 of their brief to a remark by Bessolo's counsel in the file wrapper of the Bessolo patent regarding the fact that the lower indicia surface is almost double the width of the upper indicia surface and pointing out that the accused device does not have that feature and actually embraces a smaller lower indicia surface, rather than larger.

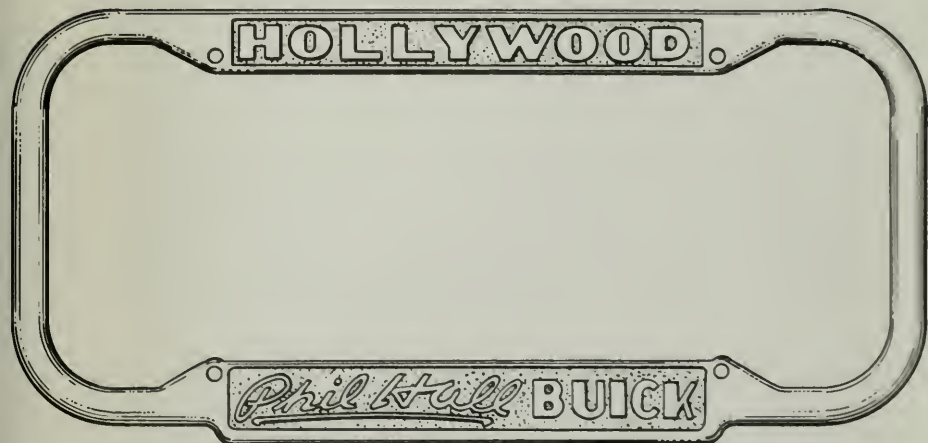
This effort to divert the Court's attention, the appellee is confident, will not be successful, and *particular reference is made to the defendants' infringing license plate, Exhibit 4*. In this case it will be observed that the lower indicia surface is approximately double the width of the upper indicia surface, *exactly as in the Bessolo patent*. Also, it will be observed that the over-all appearance is virtually identical to the Bessolo patent. For the Court's convenience, a sketch is set forth on the opposite page showing the design of the Bessolo patent and the design of the infringing device, Exhibit 4.

Further, it is not difficult to see that the Eddie Nelson infringing device Exhibit 2 is really the same design, but merely reversed through 180 degrees. Such reversal is common in the trade and it has been conceded that it is customary in the trade to supply license frames with a larger insert either on the bottom or on the top, as the customer may desire, and that the holes for mounting are uniform so that it may be thus reversed and work either way. [R. 31.] Such reversal in no way changes or affects the design.

When these facts are observed in particular reference to the emphasis appellants place upon the fact that the



**BESSOLO DESIGN PATENT 167,878, IN SUIT
PLAINTIFFS EXHIBIT "I"**



**ACCUSED DEVICE
PLAINTIFF'S EXHIBIT "4"**

lower portion of the Bessolo design is broader than the upper portion and the inaccurate drawings attached to the appellants' brief, it is clear that an exact infringement exists in the case at bar.

Comparing, once again, the features of the defendants' frames and of the Bessolo patent, it is observed that the over-all design is substantially identical; that the infringing articles, compared with the patent and plaintiff's frame embodying the patent design, are substantially identical in all respects; that the surface area upon which the letters are placed is dimpled in the patent and the infringing frame; that all are indented in a similar manner; that the letters are placed thereon in a similar manner; that the curvatures are substantially identical, and the placing of holes for mounting with reference to the advertising portions is substantially identical. Indeed, the Court found in Finding No. 10 as follows:

"The license frames exemplified by Exhibit 2 sold by Robert W. Brown and Robert W. Brown & Co., Inc., to Eddie Nelson and others are substantially identical with the patent in suit, Exhibit 1, and frames made by plaintiff thereunder as exemplified by Exhibits 3 and 3-A. Said frames sold by Defendants incorporate the new and ornamental design of the patent in suit, are in all respects substantial duplicates thereof, embody the invention of said Letters Patent, and are an infringement thereof." [R. 19.]

The finding of the Court makes it clear that the *Defendants' frames infringed the patented design*, that the Court inspected the Plaintiff's frames embodying his design and that such inspection only further confirmed the Court's finding of infringement.

E. The Law of Infringement Sustains the Judgment of the Lower Court.

The law as heretofore expressed with reference to the case of *Gorham v. White*, as quoted in the *Glen Raven etc. v. Sanson etc.*, 189 F. 2d 845, 89 U. S. P. Q. 470, is equally applicable to the point made here. Since an exhaustive review of this law was heretofore quoted, it will not be again reviewed, except by brief reference.

The Court said in the *Gorham* case:

“We hold therefore, that if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.”

Further, in one of the hosiery cases: *Sanson Hosiery Mills, Inc., et al. v. H. H. Kress Co., Inc.*, 109 Fed. Supp. 383, 384, 95 U. S. P. Q. 142:

“Actual comparison for minute inspection is not a fair test. The imitation may be on display when the patented article is not present. In such a situation one seeking a stocking with a picture frame border would readily accept the imitation. A counterfeited \$20.00 bill may be fairly easy to detect by one reasonably skilled in handling money if a genuine bill is present for comparison, but it is extremely difficult to detect some of them in the absence of a genuine one for comparison. A design patent protects the general design, the pictured effect on the mind from a general view, rather than details revealed by a minute test. Therefore, testimony of a comparison test is not exclusive nor conclusive.”

The Court recognizes that the majority of all patents in this modern day are for a combination of elements. Most of these separate elements could be found some place in the prior art, and this does not act to bar or prevent the invention by appropriate combination. Reference is once again made to *Dobson v. Dornan*, 118 U. S. 10, 15:

“A design which avails itself of suggestions old in the art is patentable if, as a whole, it produces a new and pleasing impression on the aesthetic sense. *Martineux & Willard Mfg. Co. v. American Lamp & Brass Co.*, 3 Cr., 103 F. 634, 639.”

This point is further emphasized by the Court of Appeals for the Sixth Circuit in *Forestek Plating & Mfg. Company v. Knapp-Monarch Company*, 106 F. 2d 554, 43 U. S. P. Q. 39, in which a design patent was held valid and infringed. The Court said, among other things, at page 560:

“The object of the design statute is to encourage the decorative arts, and a new design, if it does no more than please the eye, is the proper subject of a design patent, regardless of utility, even though it is a reassembling or regrouping of familiar forms and decorations. [Citing cases.]”

IV. CONCLUSION.

In the case at bar *the Bessolo design has been found both by the Patent Office and the Trial Court to be completely new*, and to involve invention over the prior art, and to the extent that it embraces any previously disclosed art, it puts it in an entirely new and pleasing combination, as indicated by commercial success and copying. The Trial Court had ample opportunity to examine all wit-

nesses and evaluate all evidence of whatever nature. The Bessolo design has arranged various elements in a particularly attractive stream-lined fashion, and the defendants have infringed by making and selling a substantially identical copy of the Bessolo patent. The relationship of the defendant Robert W. Brown to the U. S. License Frame Manufacturing Company was such that he had ample opportunity to present the Bessolo design to the trade and learn of its popularity; in so doing, he took and used the substance of the Bessolo patent. The Court found in particular:

1. That the patent in suit "Clearly discloses and claims a new and ornamental design" [R. 24]; and

2. That the defendants' license frames "incorporate the new and ornamental design of the patent in suit, are in all respects substantial duplicates thereof, embody the invention of said Letters Patent, and are an infringement thereof."

The Judgment of the District Court should be affirmed.

Respectfully submitted,

FULWIDER, MATTINGLY & HUNTLEY,
ROBERT W. FULWIDER and
WILLIAM K. YOUNG,

Attorneys for Appellee.